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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/250,711 02/16/99 KIGHT

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EXAMINER

LM02/0929

PORTER WRIGHT MORRIS & ARTHUR
MARK E DUELL
41 SOUTH HIGH STREET
COLUMBUS OH 43215

WEINHARDT, R

ART UNIT

PAPER NUMBER

2764

DATE MAILED:

09/29/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.
09/250,711

Applicant(s)
Kight et al.

Examiner
Robert Weinhardt

Group Art Unit
2764



- ☐ Responsive to communication(s) filed on _____.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire THREE month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-33 is/are pending in the application.
- Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-33 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claims _____ are subject to restriction or election requirement.

Application Papers

- ☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☒ Notice of References Cited, PTO-892
- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2
- ☐ Interview Summary, PTO-413
- ☒ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 33 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 33 is not clear in that it recites a database comprising information alone. Information by itself has no specific structure and thus it is not clear what is being claimed.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claim 33 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 33 is directed to a database comprising information. The database is not recited as being supplied on a computer-readable medium, nor is the information

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therein recited as functional descriptive material such as a computer program or a data structure. As a result, claim 33 is directed to non-functional descriptive material and is seen to be non-statutory.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-33 are rejected under the judicially created doctrine of double patenting over claims 1-3 of U. S. Patent No. 5,383,113 and claims 1-21 of U.S. Patent No. 5,873,072 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patents and are covered by the patents since the patents and the application are

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claiming common subject matter, as follows: a method and system for paying bills electronically including use of payment type.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

7. Claims 1-33 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-15 of copending Application No. 09/250663 and over claims 1-35 of copending Application No. 09/250,675. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: a method, system and article of manufacture for paying bills electronically.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

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Applicant is reminded to maintain a clear line of demarcation between the pending applications.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

9. Claims 1-15 and 17-33 are rejected under 35 U.S.C. 102(e) as being anticipated by Lawlor et al.

Lawlor et al. teaches a method of paying bills using a computer comprising receiving a request to pay a bill of a merchant on behalf of a consumer (abstract, figs. 12, 14a-14d); determining a consumer's account number from a database (col. 33 lines 3-60, col. 31 lines 50-58) and paying a plurality of bills of each of a plurality of consumers by a single financial instrument including a check or electronic funds transfer (col. 33 line 63 to col. 34 line 4).

With regard to the use of an account other than the deposit account of the customer to pay the bills, Lawlor teaches that the customer's bills are paid to a service provider's account and that the service provider then pays the merchant (col. 19 lines

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9-11, col. 23 lines 34-38, col. 49 lines 7-28). Lawlor further teaches detecting duplicate requests to pay a bill (col. 43 lines 58-68) and teaches that funds can be directly transferred from the consumer's account to the ultimate payee's account (col. 49 lines 20-28).

Lawlor further teaches accessing the merchant's bank routing number necessary for an electronic funds transfer, determining a consumer's deposit account and preparing a draft or electronic funds transfer on funds in that account. See the sections of Lawlor cited above. See also col. 42 line 60 to col. 43 line 68, col. 49 lines 7-40 of Lawlor.

Lawlor also teaches selecting a payment type from a group consisting of a first payment type and a second payment type and directing payment of the bill using the selected payment type (col. 20 lines 59-67, col. 33 lines 3-60 particularly lines 15-16 and 55-57). Lawlor also teaches that the first type is an electronic funds transfer, the second includes a check and that the type is determined by accessing a database of merchant information and determining the type for that merchant.

Concerning the recitation that the step of selecting a payment type includes the evaluation of the amount of the bill, as it is not explicitly recited how the results of the evaluation are used, Lawlor is seen to meet this limitation as the amount of the bill in Lawlor is evaluated to determine if the customer has sufficient funds in his account.

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With respect to the recitation of an article of manufacture comprising a computer readable medium and software, as the system of Lawlor is a computer system, its operation is seen to be inherently directed by a computer readable medium storing software.

Concerning the recitation of a communication switch, note that the bill payment system of Lawlor operates over telephone lines. As a result, the hardware necessary to perform this function is seen to include a communication switch.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

11. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lawlor et al.

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Note the teachings of Lawlor mentioned above. Lawlor fails to specifically teach comparing a consumer's received deposit account number with the consumer's deposit account number in a financial institution's database and correcting the account number if it is incorrect.

However Lawlor does teach storing the deposit account number in a database. Further, it is well known in the art, and Official Notice is taken thereof, to verify user supplied data via a source other than the user. Since the service provider in Lawlor is to pay a bill using the account number given by the user and incorrect account data would obviously prevent appropriate payment of the bill by the system of Lawlor, it would have been obvious to those of ordinary skill in the art to modify the teachings of Lawlor to verify the account number provided by the consumer. Since the source most likely to have the correct account data would have obviously been the consumer's own bank holding the account, it would also have been obvious to those of ordinary skill in the art to check the consumer's given account number with the consumer's account number in the bank's files or database. As no bills will be properly paid until the correct account number is provided in the database of Lawlor, it would have further been obvious to those of ordinary skill in the art to correct any incorrect account number received from a consumer.

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12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


Thomson et al., Delfer, III et al., Benton et al. and Josephson teach bill payment systems.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Weinhardt whose telephone number is (703) 305-9780. The examiner can normally be reached on Monday-Friday from 7:30 AM - 4:00 PM. The examiner can also be reached at the e-mail address: robert.weinhardt@uspto.gov

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell, can be reached on (703) 305-9768. Facsimile transmissions to this Group may be directed to (703) 308-1396.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

September 26, 1999


ROBERT A. WEINHARDT
PRIMARY EXAMINER